

JUDGE KOELTL

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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

Born To Rock Design Incorporated,

Plaintiff,

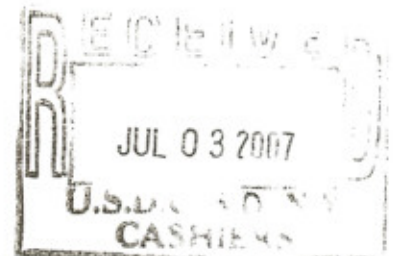
v.

BigTime TV Limited,

Defendant.

Civil Action No.

ECF CASE



COMPLAINT

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UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

Born To Rock Design Incorporated,

Plaintiff,

v.

BigTime TV Limited,

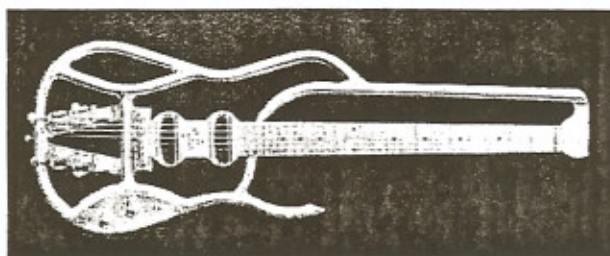
Defendant.

Civil Action No.

COMPLAINT

Plaintiff, through its attorneys, alleges for its complaint against Defendant:

1. Plaintiff Born To Rock Design Incorporated (hereinafter "BTR") is a New York corporation with offices in the Borough of Manhattan, within this judicial district. BTR has used, sold, advertised, exhibited, promoted and distributed in commerce (including without limitation interstate and foreign commerce) electric guitars in connection with the designation BORN TO ROCK:



2. As used herein, the term "guitar" indicates both guitars and bass guitars (larger guitars tuned to a lower pitch). Related goods and services of BTR in connection with its guitars include without limitation guitar picks, t-shirts, instrument parts and accessories, instructional matter, online and telephone instruction and advice, online viewable and downloadable music photo gallery, competitive endorsement and award program, band sponsorship, music instruction and performance, "roadie" and tech services, instrument and equipment repair and sales, invention R&D, online auctions, music downloads and music software. BTR's business has been conducted in commerce by BTR or its licensor since at least as early as 1992.
3. The BORN TO ROCK brand of guitars is well and favorably regarded in the music trade and by musicians in the U.S. and around the world, and in the trade and general press (ranging from Metal Edge to The Wall Street Journal). The trademark BORN TO ROCK is incontestably registered in the U.S. to BTR's licensor. BTR is the sole and exclusive licensee and its activities are supervised directly by the trademark owner, who is the President of BTR. The trademark BORN TO ROCK is registered to BTR's licensor for "electric guitars" under Reg. No. 1,846,682; it is incontestable due to the timely filing of a Sec. 8/15 declaration; and was duly renewed in 2004.
4. BTR's genuine BORN TO ROCK guitar is a patented design (Pat. 4,915,009) that solves the age-old problem of neck warping in an ingenious manner: by separating the function of string tension from the function of fretted intonation.

As a result of its unique design, the BORN TO ROCK guitar is light, comfortable, stable, resonant and holds its pitch even when transported around the world, such as from New York to Hong Kong by air.

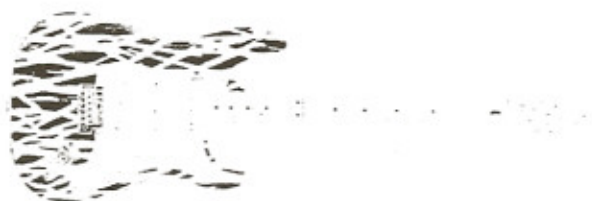
5. The BORN TO ROCK guitar is suitable for all styles of music, from country and jazz to heavy metal. Being as the body is made of brushed aluminum tube, its stage impression appears particularly apt for "metal" styles of rock music. The BORN TO ROCK guitar has been owned and used by musicians, including celebrity musicians, in at least the U.S., Canada (a part of the British Commonwealth), Japan, Switzerland and Hong Kong (including at the time it was part of the British Commonwealth).
6. The heavy-metal band VOIVOD has prominently used the BORN TO ROCK guitar on tour; VOIVOD's lead guitarist, Dennis (a/k/a "Piggy") played a BORN TO ROCK guitar (as seen in photographs documenting such use on the website www.Voivod.net; such photographs have, on information and belief, repeatedly been viewed by VOIVOD fans around the world). The band VOIVOD garnered substantial media attention since the bass-guitar player from METALLICA, Jason, left METALLICA and joined VOIVOD. While Piggy is deceased, his Estate plans to issue commemorative figurines of Piggy playing his BORN TO ROCK guitar (to be made under license from BTR). The figurines will be made by a French company and, on information and belief, will be distributed in the U.S., Canada, France, and elsewhere (since VOIVOD, Piggy and his BORN TO ROCK guitar are world-famous).

7. The guitar trade is an international business since musicians go on tour all over the world. Publications in the guitar trade, such as the Blue Book of Guitars and the Music Trades Directory, are distributed all over the world. The BORN TO ROCK guitar is listed in such publications and has been for many years, long prior to the acts complained of herein. BORN TO ROCK guitars are publicized worldwide by BTR at its website www.BornToRock.com, and have been for many years.
8. Defendant BigTime TV Limited (hereinafter "BTR-UK") is on information and belief a private limited company under the laws of the UK with registered offices in London, England (Company No. 05202758). BTR-UK procured the confusingly-similar domain name www.BornToRock.tv and since no earlier than 2005 has held itself out as an exhibitor and marketer of electric guitars under the designation BORN TO ROCK; ostensibly for charitable purposes but, on information and belief, at the same time financially enriching its principals and managers.
9. On information and belief, BTR-UK knew (prior to the acts complained of) of the domain name and trademark and trade name use and ownership of BORN TO ROCK by BTR. BTR-UK nevertheless willfully and intentionally proceeded in disregard thereof. On January 15, 2007, when BTR first learned of BTR-UK, BTR provided actual notice of registration and warned BTR-UK to cease and desist; but BTR-UK disregarded it and has proceeded with its unlawful activities.

10. On information and belief, BTR-UK contacted celebrities -- including New York celebrities such as Diane von Furstenberg and Jennifer Lopez -- to procure their assistance to "design" electric guitars to be auctioned under the designation BORN TO ROCK. BTR-UK also, on information and belief, contacted guitar makers headquartered in the U.S., such as Fender and Gibson, to procure their donation of electric guitars to be decorated by celebrities and exhibited and auctioned; and did so procure such guitars and arranged for their decoration.
11. BTR-UK proceeded to exhibit and auction such guitars in London, with an accompanying online internet exhibition and auction site it arranged through Ebay, a company with headquarters in the U.S.; having actively promoted said site to potential bidders in the U.S. to facilitate their purchases. On information and belief, the auction was planned for Harrod's, but Harrod's became concerned about BTR's prior rights so it was moved to Gibson Hall. The auction was conducted simultaneously live and on the internet, with bids being interactively solicited online from bidders within the U.S., including bidders within this District. To the extent guitars in the unauthorized BORN TO ROCK auction were purchased by Americans as the winning bidders (not presently known), BTR-UK on information and belief shipped (or arranged to ship) them to the U.S. in fulfillment of its auction contracts.
12. BTR-UK, on information and belief pursuant to its announced publicity as to its charitable intentions (including without limitation its online publicity specifically aimed at and calculated to appeal to the U.S. market featuring

U.S. guitars, guitar brands and guitar makers, U.S. celebrities and U.S. charities), furnished at least part of the proceeds from the auction to charities having offices within the U.S. and doing business within this District, such as Al Gore's anti-global-warming foundation The Climate Project.

13. BTR-UK also sold, and continues to sell via Ebay, BORN TO ROCK t-shirts and guitar exhibition and auction catalogs. It also provides an online facility for persons, including those located within this District, interactively to "design" their own electric guitars by decorating them.
14. BTR-UK's online interactive guitar-design facility conveys a misleading impression concerning guitar design. It suggests that a guitar can be "designed" merely by selecting a conventional body style (STRATOCASTER or LES PAUL) and applying a new paint job to it. This reinforces the hidebound thinking that electric guitars should be made in one of those two body styles and that any changes to established designs should only be superficial. For example, BTR-UK's Diane von Furstenberg celebrity guitar is a Fender STRATOCASTER guitar which Ms. von Furstenberg has painted to resemble fabric for a dress:



15. BTR, in contrast, employs a design philosophy of continual improvement in which all elements of guitar design are open to fundamental reconsideration, without being bound by past forms. By reinforcing the opposite approach through its online interactive guitar-design website, and indeed by procuring and displaying celebrities' implicit endorsements of that approach under and in connection with the designation BORN TO ROCK, BTR-UK retards the progress of guitar design; conditions the public to adhere to old forms; and irreparably injures BTR's goodwill by inter alia diminishing the unique appeal of its innovative guitar design and blurring the desirable secondary meaning of the designation BORN TO ROCK as an indicator of source. In short: a STRATOCASTER with a new paint job is not a genuine BORN TO ROCK guitar.
16. Indeed, the very idea of paint is antithetical to the design philosophy behind the genuine BORN TO ROCK guitar. It has no paint on the body. It is hand-crafted of bent and welded aluminum, like a modern-art sculpture. The surface is brushed to a fine satin finish. The overall impression is of a dynamic and powerful machine like a fighter jet or a customized motorcycle. Its natural color is silver, but due to the brushed finish it reflects light. Hence, the perceived color of the BORN TO ROCK guitar is variable under control of the guitarist and his/her stage-lighting director. The color of reflected light changes during a concert as the stage lighting changes to suit the songs being performed:



17. In contrast, conventional guitars like the STRATOCASTER and the LES PAUL (the models on BTR-UK's unauthorized "design your own guitar" interactive website) are made of hardwood. They are finished to look like wooden furniture by applying wood stain, paint and varnish. By reinforcing the idea that guitars are supposed to be painted like furniture, BTR-UK's unauthorized interactive website misleads the public into thinking that the BORN TO ROCK guitar is a conventional painted guitar; it conditions them to expect a guitar to be made of painted wood like furniture; and it irreparably interferes with BTR's promotion and sale of its innovative polished-metal guitar design (which aims for the aesthetic of a fighter jet or customized motorcycle, rather than furniture).

18. Fender and Gibson, being the largest and oldest U.S. guitar makers, are principal competitors of BTR. Their guitar models the STRATOCASTER and the LES PAUL (the very ones being utilized by BTR-UK) are outmoded designs from the 1950s, which do not perform as well as the genuine BORN

TO ROCK patented design. By falsely associating the designation BORN TO ROCK with the outmoded guitar styles used by Fender and Gibson, BTR-UK irreparably injures BTR's efforts to educate musicians about the advantages of its patented design, and confuses them into thinking that the designation BORN TO ROCK has a connection or affiliation with, or sponsorship by, Fender, Gibson and/or BTR/UK.

19. The metatags employed by BTR-UK on its unauthorized website

www.BornToRock.tv expressly show that they use BORN TO ROCK for purposes of trade ("Born To Rock&trade"); include the fanciful compound expression "borntorock" derived from BTR's prior website "borntorock.com"; and highlight BTR-UK's intention to promote Fender and Gibson guitars (brands competitive to genuine BORN TO ROCK guitars) worldwide through the employ of "world renowned creatives" to appeal to BTR's target customers "rock and roll and electric guitar enthusiasts":

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<!DOCTYPE html PUBLIC "-//W3C//DTD XHTML 1.0 Transitional//EN"
"http://www.w3.org/TR/xhtml1/DTD/xhtml1-transitional.dtd">
<html xmlns="http://www.w3.org/1999/xhtml" lang="en" xml:lang="en"
xmlns:v="urn:schemas-microsoft-com:vml" xmlns:o="urn:schemas-
microsoft-com:office:office">
<head>
<title>Born To Rock&trade; Electric Guitar Exhibition</title>
<meta http-equiv="Content-Type" content="text/html; charset=utf-8" />

<meta name="DCSext.WebsiteProfile" content="Born To Rock" />
<meta name="keywords" content="electric guitar, charity auction, rock and
roll, Gibson, fender, borntorock, rock & roll, cult guitars, fender guitar,
history, bigtime, guitar exhibition" />
<meta name="description" content="Born To Rock &#150; The Life and
Times of the Electric Guitar 1931&#150;2006 - Electric Guitar Charity
Auction featuring Fender Electric guitars designed by world renowned
creatives for rock and roll and electric guitar enthusiasts." />
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20. The use of a TM symbol by BTR-UK on its website homepage, emphasizes that BTR-UK knows that it is not using BORN TO ROCK as an ordinary-language expression, but rather as a trademark (TM):

"This heart of the extraordinary Born To Rock™ exhibition is a collection of personally customised electric guitars, created by some of the biggest names in music, fashion and design."

21. On December 5, 2006, BTR-UK filed an unauthorized application to register BORN TO ROCK as its trademark in the European Community, further demonstrating its knowing and intentional employment of BORN TO ROCK as a trademark and its poaching on BTR's rights.

22. While the idea of charitable guitar auctions may be laudable in principle, by conducting such auctions under the unauthorized designation BORN TO ROCK, BTR-UK impedes the ability of BTR to use such modes of publicity, distribution and sale for its own benefit. BTR has in fact previously used Ebay as a channel of distribution for genuine BORN TO ROCK branded goods.

23. The charities selected by BTR-UK to be aided, may or may not be the charities BTR would choose for itself, or whom BTR's customers and potential customers (including without limitation "heavy metal" musicians, some of whom have strongly-held and well-publicized political views) would wish to aid. BTR's goodwill and reputation therefore are subjected by the unauthorized acts of BTR-UK to influences and effects beyond BTR's control, without BTR's approval or consent.

24. On information and belief, BTR-UK intends to bring its guitar exhibition and auction activities directly to U.S. soil in the future, per its email dated January

19, 2007; and otherwise to expand its unlawful activities within the U.S., including within this District.

25. Hence, on information and belief jurisdiction exists over BTR-UK due to its aforesaid (and likely other as yet undiscovered) contacts with the U.S. as a whole, as well as in this District specifically. Since BTR-UK is an alien, it may in any event be sued in any district (including this District) based upon its aggregate contacts with the U.S. The Court has jurisdiction over the subject matter of this action under 15 U.S.C. § 1121, and 28 U.S.C. §§ 1331 and 1338(a) and (b), as it involves substantial claims arising under the Trademark Act of 1946, 15 U.S.C. § 1051 et seq., as amended, combined with related claims for unfair competition, unfair trade practices, and deceptive acts; and under 28 U.S.C. § 1367 under the principle of supplemental jurisdiction. Venue is proper under 28 U.S.C. § 1391(b) - (d).

COUNT I: FALSE DESIGNATIONS OF ORIGIN AND FALSE DESCRIPTIONS AND REPRESENTATIONS UNDER SECTION 43(a) OF THE TRADEMARK ACT OF 1946

26. BTR repeats and realleges the allegations in the foregoing paragraphs 1 through 25, inclusive, as though fully set forth herein.

27. BTR-UK's aforesaid acts constitute the use in commerce, directly and/or contributorily, of false designations of origin and false and misleading descriptions and representations of fact which have caused and are likely to cause confusion, to cause mistake and deceive as to the affiliation, connection and association of BTR-UK with BTR and as to the origin,

sponsorship or approval of BTR-UK's commercial activities; and misrepresent the nature, characteristics and/or quality of its goods and services in violation of Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125(a).

28. The aforesaid acts of BTR-UK have caused and will continue to cause great and irreparable injury to BTR, and unless such acts are restrained by this Court, they will be continued and BTR and the public will continue to suffer great and irreparable injury. BTR has no adequate remedy at law.

COUNT II: TRADEMARK INFRINGEMENT AND UNFAIR COMPETITION

29. BTR repeats and realleges the foregoing paragraphs 1 through 28, inclusive, as though fully set forth herein.

30. BTR-UK's conduct as aforesaid constitutes, directly and/or contributorily, trademark infringement, unfair competition, misappropriation, passing off, unlawful, unfair, deceptive and fraudulent business practices, and the making of false or misleading statements in connection with the offering for sale and sale of goods and services in violation of Section 32 of the Trademark Act of 1946, 15 U.S.C. § 1114; the common law; the laws of the several states; and applicable foreign law.

31. BTR-UK's aforesaid acts have caused and will continue to cause great and irreparable injury to BTR, and unless said acts are restrained by this Court, they will be continued and BTR and the public will continue to suffer great and irreparable injury. BTR has no adequate remedy at law.

WHEREFORE, BTR prays:

1. That BTR-UK, its officers, directors, agents, servants, employees, suppliers, distributors, wholesales, sponsors, ISPs, webhosts, website designers, domain name registrars, business partners, retailers, charitable contributors, charitable beneficiaries, attorneys, successors and assigns, and all persons in privity, concert or participation with them, or any of them (including without limitation celebrity designers of unauthorized BORN TO ROCK guitars), be preliminarily and permanently enjoined and restrained: from using the designation BORN TO ROCK in connection with guitars and/or any related products or services; or any other word, symbol, or device so similar thereto (including without limitation www.borntorock.tv) as to be likely to cause confusion, to cause mistake or to deceive; from doing any other act or thing calculated or likely to cause confusion or mistake among the trade or the public or to deceive purchasers into thinking that BTR-UK's goods and/or services are BTR's goods and/or services, or come from or are affiliated with BTR, or are sponsored or approved by BTR, or come from the same source as BTR's; from encouraging the passing off of its goods and/or services in place of BTR's; and from otherwise engaging in unfair business acts and practices or competing unfairly with BTR or causing harm to its reputation; from producing or authorizing or engaging anyone to produce goods and/or services confusingly similar to the goods and/or services provided by BTR in

connection with the mark BORN TO ROCK; or from distributing or in any way offering to the public goods and services confusingly similar thereto.

2. That BTR-UK be ordered to withdraw and cancel each and every one of its trade and/or service mark applications and/or registrations of BORN TO ROCK (or any variation thereof) in connection with guitars or related goods or services.
3. That BTR-UK be enjoined and restrained from filing trademark applications for BORN TO ROCK (or any variation thereof) in connection with guitars or related goods or services.
4. That BTR-UK be directed to distribute corrective advertising to redress the false and misleading statements and representations they have made; or that BTR be awarded an amount sufficient to prepare and disseminate the same.
5. That BTR-UK be ordered to deliver up to BTR for destruction all guitars, t-shirts, guitar picks, books, brochures, advertisements and promotional materials, labels, signs, prints, packages, wrappers, receptacles and other written or printed materials in their possession or control that bear the designation BORN TO ROCK or any simulation thereof; and that BTR-UK be ordered to deliver up to BTR for destruction all designs, drawings, printing devices, plates, molds, matrices and other means for making the same.
6. That BTR-UK be directed to file with the Court and serve upon BTR (within 30 days) a written report, under oath, setting forth in detail the manner and form in which it complied with such injunction.

7. That BTR recover BTR-UK's profits arising from the use and sale of the complained-of marks, names, goods and/or services, and BTR's damages arising therefrom; and pursuant to Section 35(a) of the United States Trademark Act of 1946, 15 U.S.C. § 1117(a), that BTR recover an amount which is three times the amount found as actual damages arising out of BTR-UK's aforesaid acts.
8. That BTR be awarded punitive damages, in an amount to be determined at trial, by reason of the willful and wanton nature of BTR-UK's acts.
9. That BTR be awarded its reasonable attorneys' fees.
10. That BTR have and recover its costs and disbursements.
11. That BTR have such other and further relief as the Court may deem just.

Dated: July 2, 2007

Respectfully submitted,
R. KUNSTADT, P.C.

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